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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Superchips, Inc.

Serial No. 76424590

David L. Sigalow and Ava K. Doppelt of Allen, Dyer, Doppelt, Milbrath & Gilchrist for Superchips, Inc.

Rebecca Gilbert, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Simms, Walters and Chapman, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Superchips, Inc. filed an application to register on the Principal Register the mark SUPERCHIPS INC. for, as amended, "hand-held electronic computers for use in programming automotive computers," in International Class 9.¹ During the prosecution of this application, applicant amended the application to include the following statements:

- "The word INC. is disclaimed apart from the mark as a whole." (We note, however, that

¹ Serial No. 76424590, filed June 25, 2002, based on use of the mark in commerce, alleging first use and use in commerce as of 2000.

the Examining Attorney stated that the disclaimer is not acceptable because the entire trademark is merely descriptive.)

- "Applicant is the owner by assignment of Registration No. 1,876,383." (We note that this registration is for the mark SUPER CHIP for "computer chips for automobiles," which mark is registered under Section 2(f) of the Trademark Act with a disclaimer of CHIP apart from the mark as a whole.)

Applicant further stated that "the subject goods contain computer chips and they are used to program computer chips"; and that "the wording "SUPERCHIPS" has no significance in the relevant trade or industry or as applied to the goods."

The Trademark Examining Attorney issued a final refusal to register, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark is merely descriptive in connection with its goods.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

The Examining Attorney submitted definitions from *The American Heritage Dictionary of the English Language* (3rd ed. 1992) of "super" as "very large, great, or extreme," and of "chip" as "*electronics*[,] a minute slice of a semiconducting material, such as silicon or germanium, doped and otherwise processed to have specified electrical characteristics, especially before it is developed into an electronic component or integrated circuit[;] also called a

microchip." She contends that "the computer and automotive industries widely use the term 'superchips' or 'super chips' to describe chips which are very fast or have large memories" (brief, p. 3); that applicant's goods are hand-held computers containing chips and that these computers program "any and all types"² of automotive computer chips; that the chips programmed by applicant's computer encompass super chips; that, therefore, the mark SUPERCHIPS INC. is merely descriptive in connection with the identified goods; and that the addition of INC. to the descriptive term SUPERCHIPS does not alter the descriptive nature of the mark.

In support of her position, the Examining Attorney submitted excerpts from different Internet web sites that use the term "super chips." The following are representative examples:

Diesel Services Group ... High Performance Ford Powerstroke Diesel Accessories and Parts - Company provides Ford Powerstroke diesel accessories and parts like turbochargers, **super chips**, fuel supply pumps, injectors, injection pumps and more to enhance your 7.3 Power Stroke engine.
(www.millbrook.com)

Integrating large amounts of memory cost effectively becomes the bottleneck to designing these "**super chips**." Memory providers pack the dense memory structures using aggressive design rules, which in turn causes them to be more defect-prone. (www.esilicon.com)

² The Examining Attorney is quoting applicant in its response of December 16, 2003, p. 1.

Super chips, electronic devices that alter the engine computer's programming are another popular aftermarket performance part. These chips enrich fuel delivery and advance ignition time for increased performance, but at the expense of fuel economy and emissions. (www.ca.autos.yahoo.com)

Even compared with today's **super chips** that exceed 1 gigahertz (GHz), the relatively modest (and far less expensive) 500-MHz processor can hardly be called a slowpoke when it launches an application or refreshes a large spreadsheet calculation in a second or two. (www.aicpa.org)

Applicant describes its product as "hand-held devices used by automotive companies and repair services to program and to maintain the computers that are built into contemporary automotive vehicles" (brief, pp. 3-4) and contends that SUPERCHIPS is "a compound coined term ... [that] "is more related to puffery" (brief, p. 4). Applicant also contends that its mark connotes two meanings and, therefore is not merely descriptive. Applicant makes the following argument in this regard:

[T]he term "CHIPS" is an acronym used by the California Highway Patrol, an organization that is known nationally for its high-speed car chases. Such high-speed performance is suggestive of the high-speed performance that would be acquired using the "SUPERCHIPS" product line. A segment of adult consumers of the purchasing public outside of California would also recognize the term CHIPS to mean California Highway Patrol because of the popular television series, by the name "CHIPS" which was syndicated in the early 1980's. Therefore, the term "CHIPS" has associations beyond its association with microchips and is suggestive of high performance vehicles. (Brief, p. 5.)

Applicant's mark might somehow suggest that the hand-held device that is its product will "supe"

(phonetically "soup") up the performance of automotive vehicles, by enhancing automotive computer performance. Far from being descriptive, this subliminal connotation suggests improved vehicle performance in a way that true automotive aficionados can understand and appreciate. (Brief, pp. 6-7.)

About the potential purchasers and users of applicant's goods, applicant makes the following statements:

Those persons who would purchase SUPERCHIPS hand-held electronic devices for programming automotive computers are extremely interested in the performance of their automotive vehicles; however, they may or may not have experience with computer hardware. It is likely that some SUPERCHIPS buyers would not be familiar with the term "superchips" as applied to ... high-speed computer applications. (Brief, p. 6.)

Applicant believes [the Examining Attorney's conclusion that the mark is merely descriptive] presupposes that an automotive mechanic, given the job of re-programming an automotive computer which was installed within a vehicle at the time of production, has any knowledge as to the type of "chips" that may be found within said automotive computer. Such a finding also presuppose[s] that this mechanic has any particular interest in the nature of the chips that may be found within the SUPERCHIPS product or within the automobile itself, or whether the on-board computer has any relationship with the programming device. (Brief, p. 7.)

[C]onsumers [of applicant's goods] will seek to increase vehicle performance or to fix the car through the act of reprogramming an automotive computer using the subject goods. The emphasis is on the outcome - increased or optimum performance - and not the process to achieve that outcome. Therefore, such consumers are likely to perceive the subject mark SUPERCHIPS INC. as suggestive of the subject goods. (Reply Brief, p. 4.)

The test for determining whether a mark is merely descriptive is whether it immediately conveys information

concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

As a further elaboration on these propositions, the mere descriptiveness of a mark is not determined from the standpoint of all consumers, but rather is determined from the standpoint of the relevant purchasing public of the goods and/or services for which registration is sought. *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552-53 (Fed. Cir. 1991) ("The precedents of this court both before and after the 1984 Act have consistently applied the

traditional *purchaser* understanding test. For example, this court has stated that whether a term is entitled to trademark status turns on how the mark is understood by the *purchasing public*.”) (*emphasis added*); and *In re Montrachet S.A.*, 878 F.2d 375, 11 USPQ2d 1393, 1394 (Fed. Cir. 1989) (“Whether a term is entitled to trademark status turns on how the mark is understood by the *purchasing public*.”) (*emphasis added*).

If, however, when the goods or services are encountered under a mark, a multistage reasoning process, or resort to imagination, is required in order to determine the attributes or characteristics of the product or services, the mark is suggestive rather than merely descriptive. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); and *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992).

The Examining Attorney bears the burden of showing that a mark is merely descriptive of the identified goods or services. See *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 21567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

The evidence clearly establishes a *prima facie* showing that “superchips” or “super chips” is a widely used term that identifies a computer chip that has increased memory or speed, or both; and that, as applicant admits, its product is used to reprogram all types of computer chips in

automobiles, which would include superchips. Further, applicant's identification of goods is not limited and could encompass or include superchips in its manufacture. Therefore, the term "superchips," which identifies something within applicant's product that increases the speed or memory of the device or enables the user to program a "superchip" in an automotive engine, refers to a significant desired feature of applicant's product.

Applicant describes the users of its product as repair shop mechanics making adjustments to an automotive engine and auto owners seeking to make engine adjustments to improve the performance of their automobiles. In view of the desirability of the "superchip" feature of applicant's product and the evidence that the term "superchip" appears in common parlance, it is highly likely that the relevant consumers will understand the above-described meaning of this term as it relates to applicant's products.

We find applicant's proposed alternative connotations of the term "superchips" to be highly unlikely as applied to these goods and, in any event, there is no evidence to support applicant's contention that such a connection would be made.

We find, in conclusion, that, when applied to applicant's goods, the term SUPERCHIPS INC. immediately describes, without conjecture or speculation, a significant

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feature or function of applicant's goods, namely, that applicant's goods contain computer chips with increased speed or memory or that it programs such chips in automotive engines. The term INC. at the end of applicant's mark has no trademark significance. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's goods to readily perceive the merely descriptive significance of the term SUPERCHIPS INC. as it pertains to applicant's goods.

Decision: The refusal under Section 2(e)(1) of the Act is affirmed.